

III. REMARKS

Status of the Claims

Claims 1-3,6,10,14,16,17,19, and 23 are amended. Claims 1-26 are presented for further consideration.

Summary of the Office Action

Claims 1-5,10,11, 14-18, 23 and 24 stand rejected stand rejected under 35USC102(e) on the basis of the cited reference Verdonk, U.S. Patent No.6,330,454. Claims 6-9, ,19-22, stand rejected under 35USC103(a) based on the reference Verdonk in view of the cited reference Willars, et al, U.S. Patent No. 6,285,667. Claims 12,13 25, and 26 stand rejected under 35USC103(a) based on the reference Verdonk. The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks.

Applicant has amended the claims in response to the examiner's objections and to overcome the rejections based on 35USC112.

Discussion of the Cited Reference

The Examiner relies on the cited reference Verdonk to support the rejection based on anticipation and as the primary reference to support the rejection based on obviousness.

Referring to the disclosure of Verdonk, in order to obtain location information, a page is initiated to a mobile unit and the mobile unit responds. The location is estimated solely on the basis of cell/sector identification information contained in the response (see col. 6, at lines 9-12). Verdonk does not suggest using any other information in the page response and in

fact makes certain assumptions in order to obtain a more specific location, for example, sectors of a cell or assigning center of location within a cell or sector thereof. This is described at length at column 6, lines 9-40 of the reference Verdonk. Such methods do not lead to as precise a location determination as in the subject system.

This application, however, teaches that the network part locates the subscriber terminal on the basis of the additional information included in the paging response message of the subject system, such as timing information, GPS estimates and measurements, signal strength measurements and other data, see paragraphs 60 and 64 of this application.

Verdonk further states, at col. 2, at line 45, as follows:

"The mobile unit responds to the page and, based upon cell/sector from which the mobile unit responded, the MSC determines an approximate location of the mobile unit."

Further, in column 7, at line 42 of Verdonk, it is stated:

"...MSC stores the cell/sector from which the mobile unit responded..."

These extracts suggest that the actual "page response" may not even include the identity of the serving cell but that the identity is obtained indirectly (e.g. by monitoring from which connection/transmission line the page response is coming and identifying the serving cell from this information).

The subject application in claim 1 indicates:

"...the core network of the radio system transmitting a location service request message to the radio network...the radio network transmitting information to a subscribe terminal in a paging message that the subscriber terminal is requested to initiate the location service".

Verdonk, on the other hand, teaches:

"If the location information to be determined requires that a current location of the mobile unit 128 be found, the serving MSC 102 initiates a page to the mobile unit 128, with the mobile unit 128 responding via base station 106 and BSC 104. Based upon this response to the page, the serving MSC 102 determines particularly that the mobile unit 128 resides within cell 144."

In the subject application, the core network requests the radio system for location service and the radio system requests that a mobile terminal initiate a paging procedure for this purpose.

In the subject application, the radio network transmits information to the terminal in a paging message that the terminal is requested to initiate the location service. Verdonk however describes that "standard paging techniques may be employed" (col. 8, from line 26), which suggests that, in Verdonk, it is assumed that conventional paging procedures are used (such as paging procedures for usual network originated voice calls etc.) by the network to initiate directly a location request.

This indicates another important difference in the system of this application, as the mobile unit is requested to initiate the location service. This allows the user of the contacted terminal to become aware of the location service request, whereas the solution of Verdonk does not achieve this. Verdonk merely aims to use a paging procedure for getting a cell identity, whereas

the application of the applicant proposes enhancing the paging procedure (or creating a new one) for location purposes. There are several benefits gained from this awareness at the mobile terminal, for example, privacy and location accuracy.

The system of Verdonk is, therefore, missing several features of the subject application according to independent claim 1 and 14, as amended. Accordingly, the reference Verdonk does not support the rejection based on anticipation.

The Issue of Anticipation

It is well settled that a claim is anticipated, "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (See CHISOLM, Federal Circuit Guide, Pg. 1221).

The elements of the claim and their function and purpose within the claim must be reviewed in a manner similar to an infringement analysis. If the device described in the cited reference would not infringe if it was later, it will not anticipate if the reference is earlier.

Applying this analysis to the system of the cited reference Verdonk, it is observed that several features are missing.

For example, claim 1 states:

"the radio network transmitting information to a subscriber terminal in a paging message that the subscriber terminal is requested to initiate the location service;

the subscriber terminal that received the paging message transmitting a paging response message to the radio network;

the radio network transmitting the paging response message to the core network; and

the network part locating the subscriber terminal on the basis of the information included in the paging response message, wherein said information comprises identity of a serving cell and other information useful in location termination."

Equivalent language appears in independent claim 14. Since these steps or apparatus to accomplish these steps are not present in the system of the cited reference, the system described therein, would not infringe and therefore, the reference does not support a rejection based on anticipation. This would also apply to the rejected dependent claims.

The Issue of Obviousness

The above described deficiencies of the primary reference is not remedied by the proposed combination with the teaching of the reference Willars. The system of Willars is described in column 2, lines 11-15 as follows:

"In the preferred embodiment of the present invention, the simultaneous call connection is accomplished using a unique page procedure between the core networks, generic radio access network, and mobile station to which the simultaneous calls are destined."

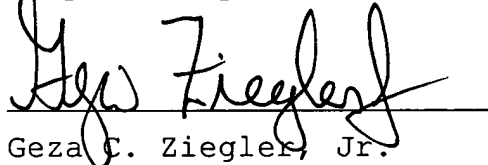
This unique page procedure allows a mobile station to receive simultaneous messages from two different core networks, while employing only a single channel between the generic radio access network and the mobile station. There is no mention of a locating service that is initiated by a page from a mobile unit. The Examiner indicates that this reference in combination with the reference Verdonk teaches the initiation of a location request by a mobile terminal. This is speculation by the Examiner, as there is nothing in these references to support the Examiner's position. Applicant submits that the modification of

the teachings of Verdonk and Willars, in order to obtain the invention, as described in the amended claims submitted herein, would not have been obvious to one skilled in the art.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



Geza C. Ziegler, Jr.
Reg. No. 44,004

27 JAN 2005

Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date:

1/27/05

Signature:



Person Making Deposit